

**REMARKS**

Claims 12, 14-17, 19-22, 24-27 and 29-31 are pending in the present application. Claims 12, 17, 22 and 27 have been amended. Claims 13, 18, 23 and 28 have been canceled.

**Claim Rejections-35 U.S.C. 102**

Claims 12-15, 17-20, 22-25 and 27-30 have been rejected under 35 U.S.C. 102(e) as being anticipated by the Elenius et al. reference (U.S. Patent No. 6,441,487). This rejection is respectfully traversed for the following reasons.

Claim 12 has been amended to include in combination the features of dependent claim 13, and thus features that the protective layer formed on the second surface of the semiconductor element "is a tape comprised of a hardened synthetic resin achieving a bonding function". Applicant respectfully submits that the Elenius et al. reference as relied upon does not disclose these features.

The Examiner has interpreted protective coating 34 in Fig. 2 of the Elenius et al. reference as the protective layer of claim 12. However, as described in column 8, lines 24-28 of the Elenius et al. reference, organic protective coating 34 is spun onto the back side of semiconductor wafer 14 using known spin coat wafer processing equipment, and is thereafter cured. In contrast, the protective layer of claim 12 is a tape comprised of a hardened synthetic resin achieving a bonding function. As described beginning on page 6, line 24 of the present application, during rear surface

polishing, protective tape 22 is first peeled from the rear surface of the wafer using UV irradiation, and then the rear surface is polished. Since no heat treatment is performed at this point, no problem occurs if protective tape 22 is peeled off. Organic protective coating 34 in Fig. 2 of the Elenius et al. reference, as spun onto the back side of semiconductor wafer 14, is not a protective tape, and thus is not removable so as to enable subsequent rear surface polishing of semiconductor wafer 14 shown in Fig. 2. Applicant therefore respectfully submits that the semiconductor device of claim 12 distinguishes over the Elenius et al. reference as relied upon by the Examiner, and that this rejection, insofar as it may pertain to claims 12, 14 and 15, is improper for at least these reasons.

Claim 17 has been amended to include the features of dependent claim 18, and thus features in combination that the protective layer formed on the second surface of the semiconductor element "is a tape which comprises a hardened synthetic resin achieving a bonding function".

Applicant respectfully submits that the Elenius et al. reference does not disclose these features, because protective coating 34 shown in Fig. 2 is a spin-coated layer, not a tape that is readily removable to enable rear surface polishing of semiconductor wafer 14. Applicant therefore respectfully submits that the semiconductor device of claim 17 distinguishes over the Elenius et al. reference as relied upon by the Examiner, and that this rejection, insofar as it may pertain to claims 17, 19 and 20, is improper for at least these reasons.

Claim 22 has been amended to include the features of dependent claim 23, and thus features in combination that the protective layer formed on the second surface of the semiconductor element "is a tape which comprises a hardened synthetic resin achieving a bonding function".

Applicant respectfully submits that the Elenius et al. reference does not disclose these features, because protective coating 34 shown in Fig. 2 is a spin-coated layer, not a tape that is readily removable to enable rear surface polishing of semiconductor wafer 14. Applicant therefore respectfully submits that the semiconductor device of claim 22 distinguishes over the Elenius et al. reference as relied upon by the Examiner, and that this rejection, insofar as it may pertain to claims 22, 24 and 25, is improper for at least these reasons.

Claim 27 has been amended to include the features of dependent claim 28, and thus features in combination that the protective layer formed on the second surface of the semiconductor element "is a tape comprised of a hardened synthetic resin achieving a bonding function".

Applicant respectfully submits that the Elenius et al. reference does not disclose these features, because protective coating 34 shown in Fig. 2 is a spin-coated layer, not a tape that is readily removable to enable rear surface polishing of semiconductor wafer 14. Applicant therefore respectfully submits that the semiconductor device of claim 27 distinguishes over the Elenius et al. reference as relied upon by the Examiner, and that this rejection, insofar as it may pertain to claims 27, 29 and 30, is improper for at least

these reasons.

### **Claim Rejections-35 U.S.C. 103**

Claims 16, 21, 26 and 31 have been rejected under 35 U.S.C. 103(a) as being unpatentable over the Elenius et al. reference, in further view of the Kim et al. reference (U.S. Patent No. 6,004,867). Applicant respectfully submits that the Kim et al. reference as secondarily relied upon does not overcome the above noted deficiencies of the primarily relied upon Elenius et al. reference. Applicant therefore respectfully submits that claims 16, 21, 26 and 31 would not have been obvious in view of the prior art as relied upon by the Examiner taken singularly or together, and that this rejection is improper for at least these reasons.

### **Conclusion**

Claims 12, 17, 22 and 27 have merely been amended to include the features of respective dependent claims 13, 18, 23 and 28, and thus have scope corresponding to respective previous claims 12, 17, 22 and 27. The above noted amendments thus should not be construed as narrowing scope within the meaning of *Festo*.

The Examiner is respectfully requested to reconsider and withdraw the corresponding rejections, and to pass the claims of the present application to issue, for at least the above reasons.

In the event that there are any outstanding matters remaining in the present

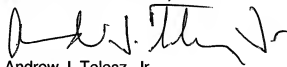
application, please contact Andrew J. Telesz, Jr. (Reg. No. 33,581) at (571) 283-0720 in the Washington, D.C. area, to discuss these matters.

Pursuant to the provisions of 37 C.F.R. 1.17 and 1.136(a), the Applicant hereby petitions for an extension of three (3) months to June 7, 2007, for the period in which to file a response to the outstanding Office Action. The required fee of \$1020.00 should be charged to Deposit Account No. 50-0238.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment for any additional fees that may be required, or credit any overpayment, to Deposit Account No. 50-0238.

Respectfully submitted,

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